

## **REMARKS**

Claims 3 and 7-10 have been amended herein. Claims 11-20 have been added. Claims 1-20 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested. Claims 3 and 7 have been amended to be in independent form. Also, claims 3 and 7-10 have been amended to enhance clarity without narrowing the subject matter recited. Support for the amendment is found in the specification, drawings and original claims.

### **Subject Matter Indicated To Be Allowable**

It was indicated in the Action that claims 3-5 and 7-10 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claims 3 and 7 have been rewritten in independent form and include all the material limitations of the original base claims. Claims 4, 5 and 8-10 each depend from one of the amended independent claims. It is respectfully submitted that pending claims 3-5 and 7-10 are allowable.

### **Comments On Statement Of Reasons For The Indication Of Allowable Subject Matter**

It is respectfully submitted that while the specific features and relationships mentioned in the statement of reasons for the indication of allowable subject matter are not disclosed or suggested in the prior art, these are not the only reasons for allowance as not all of the claims are applicable to the reasons provided. That is, the statement refers to subject matter (or language) which is not recited in all of the claims. For example, but not necessarily all-inclusive, not all of the allowable claims recite or require “determining with the machine that the intensity of the

detected second light signal does not have an intensity that varies in time with a pattern that corresponds to the first pattern. The Applicants disagree with all undue limiting remarks in the statement.

It should be understood that the allowed subject matter is to only be directed to that subject matter which is specifically recited in the claims. Any remarks in the statement which add to or subtract from the specifically recited subject matter should be disregarded. Thus, Applicants respectfully submit the statement of reasons for the indication of allowable subject matter are not applicable to all of the claims.

**The Pending Claims Are Not Anticipated or Obvious in View of the Applied Art**

Claims 1, 2, and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by So, US Patent No. 6,676,015 B2. These rejections are respectfully traversed.

**The Applied References Do Not Disclose or Suggest the Features and Relationships Recited in Applicants' Claims**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

**The Features Recited in Applicants' Claims  
Patentably Distinguish Over So**

In the Action claims 1, 2, and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by So. These rejections are respectfully traversed. Applicants response to these rejections is based on the Office's referenced interpretation of So. Thus, any change in the Office's interpretation of So shall constitute a new ground of rejection. Applicants traverse these rejections on the grounds that the So reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features and relationships recited in Applicants' claims patentably distinguish over the So reference.

### **Claim 1**

Claim 1 is an independent method claim. Applicants respectfully disagree that So discloses each every feature, relationship, and step recited in claim 1. For example, although So discloses a feed or light sensor (80), So does not disclose or suggest step (a) of claim 1 which recites generating with a first light source, a first light signal that includes an intensity that changes over time in a first pattern. In So the feed sensor includes a luminous unit and a light-intercepting unit. The light-intercepting unit senses the light irradiated from the luminous unit and a voltage value of the light-intercepting unit changes between 0V and +5V as media passes between the luminous unit and the light-intercepting unit (Column 4, lines 8-11). However, nowhere does So disclose or suggest that the light signal generated by the luminous unit changes in intensity. So only discloses that the blockage of the light signal by media causes the voltage of the light-intercepting unit to change between 0V and +5V. So does not disclose or suggest that the luminous unit generates a light signal which changes in intensity over time in a first pattern.

In addition, nowhere does So disclose or suggest step (c) which recites determining with the machine that the intensity of the detected first light signal varies in time with a pattern that corresponds to the first pattern. Although So discloses that the voltage of the light-intercepting unit changes, nowhere does So discloses or suggest determining that the pattern of the change in voltage of the light-intercepting unit corresponds to a pattern of change in the intensity of the light signal generated by the luminous unit.

Further, nowhere does So disclose or suggest step (d) which recites responsive to (c) moving at least one item through the pathway. So does not disclose using its feed sensor (80) in this manner. For example in So, the light sensor is used to sense the length of media, to decide whether or not the media is skewed, and to determine the distances between media. Nowhere does So disclose or suggest that its media is moved through a pathway responsive to a determination made regarding the correspondences between light intensity patterns.

So does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Applicants' claim 1 patentably distinguishes over the So reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection has been overcome. It follows that the claims which depend from claim 1 are likewise allowable.

### The New Claims

New claims 12-14, and 20 are dependent claims which recite computer readable media bearing software instructions which are operative to cause at least one processor in the machine to cause the machine to carry out the method steps recited in claims 1, 3, 7, and 20 respectively.

New claims 11 and 18 depend from claims 1 and 15 and recite that the first pattern includes a plurality of changes in light intensity.

New claim 15 is an independent claim directed to a currency sheet dispensing automated banking machine. Claim 15 generally corresponds to the subject matter recited in method claims 1 and/or 3.

New claims 16 and 17 depend from claim 15 and generally correspond to the subject matter recited in method claims 4 and 5 respectively.

New claim 19 is an independent method claim which generally corresponds to the subject matter recited in method claim 1.

Support for claims 11-20 is found in the Specification, Drawings, and original claims.

None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claim 11-20. These claims recite features, relationships and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

#### Additional Claim Fees

Please charge the fees associated with prosecution of two additional independent claim in excess of three (\$400) and any other fee due, to Deposit Account No. 09-0428 of InterBold.

#### Conclusion

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

  
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